

## **REMARKS**

### **I. Introduction**

As of this response, claim 13 is added, and therefore claims 7, 8 and 11-13 are currently pending in the present application. Claim 7 has been amended. Claims 7, 8, 11 and 12 have been rejected by the Office Action. In view of the following remarks, it is respectfully submitted that the pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 7-8 Under 35 U.S.C. § 102(e)**

Claims 7 and 8 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2003/0169068 to Fotouhi ( the "Fotouhi reference"). Applicants respectfully submit that claims 7 and 8 are allowable over the Fotouhi reference for the following reasons.

To anticipate a claim under § 102(e), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged exactly as in the claim. Lindeman, 730 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy , 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 7 recites the following:

7. *A device for providing a line termination of a two-wire line, comprising:  
a first terminating resistor and a second terminating resistor provided between the two wires of the two-wire line, wherein the first and the second terminating resistors are connected in series; and  
at least one switching arrangement provided between the first and second terminating resistors, wherein the at least one switching arrangement is configured to selectively individually separate each of the first and second terminating resistors from the two-wire line.*

The Fotouhi reference does not identically disclose, or even suggest, the feature that the at least one switching arrangement is configured to selectively individually separate each of the first and second terminating resistors from the two-wire line; instead, the Fotouhi reference shows in the embodiments of both Figs. 1 and 2 that resistors R1 and R2 are only collectively controlled in relation to input terminals RTIP and RRING. Specifically, transistor M1 in series with R1 and R2 is either turned on or turned off (see paragraphs 0010, 0025, 0030, 0033, 0035, 0038), thus collectively adjusting R1 and R2 relative to terminals RTIP and RRING. By contrast, the presently claimed invention requires both of the two terminating resistors to be individually selectively separable from a two-wire line.

Therefore, for at least the foregoing reasons, claim 7 and its dependent claim 8 are not anticipated by Fotouhi, and it is respectfully requested that this rejection be withdrawn.

### **III. Rejection of Claim 11 under 35 U.S.C. §103(a)**

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Fotouhi reference in view of U.S. Patent 6,853,213 to Funaba (the "Funaba reference"). Applicants respectfully submit that the combination of the Fotouhi and Funaba references does not render obvious claim 11 for the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This

teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 11 ultimately depends on claim 7. As noted above, the Fotouhi reference clearly fails to anticipate amended claim 7. Furthermore, the Funaba reference fails to remedy the deficiencies of the Fotouhi reference in regards to the rejection of claim 7. Therefore, claim 11 is allowable over the combination of the Fotouhi and Funaba references.

#### **IV. Rejection of Claim 12 under 35 U.S.C. § 103(a)**

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Fotouhi reference in view of U.S. Patent 6,853,213 ("Teggatz et al."). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

Firstly, Applicants note that the Office Action appears to mistakenly present the rejection as being based on the combination of a Yang reference and the Teggatz reference. However, since the Office Action has changed the anticipation to be over the Fotouhi reference, Applicants have assumed the present rejection was meant to be over the combination of the Fotouhi and Teggatz references.


Claim 12 ultimately depends on claim 7. As noted above, the Fotouhi reference clearly fails to anticipate claim 7, as presented. Furthermore, the Teggatz reference fails to remedy the deficiencies of the Fotouhi reference in regards to the rejection of claim 7. Therefore, claim 12 is allowable over the combination of the Fotouhi and Teggatz references.

V. CONCLUSION

Applicants respectfully submit that all pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

KENYON & KENYON LLP

 (R. No. 36,197)

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By: JONG LEE for Gerard Messina  
Gerard A. Messina  
Reg. No. 35,952

One Broadway  
New York, NY 10004  
(212) 425-7200

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